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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/992,984 | 11/05/2001 | Michael Baentsch | CH920000018US1 | 7655 |
| 53792 7590 05/28/2008 DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY. SUITE 2110 AUSTIN, TX 78759 | | | | |
| EXAMINER | | | | |
| PATEL, NIRAV B | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/992,984

Applicant(s)

BAENTSCH ET AL.

Examiner

NIRAV PATEL

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 10, 12, 14-17, 19, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 10, 12, 14-17, 19, 20, 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. Applicant's amendment filed on Feb. 27, 2008 has been entered. Claims 1, 3-6, 10, 12, 14-17, 19, 20, 22 are pending. Claims 1, 3-6, 10, 12, 14-17, 19, 20, 22 are amended and Claim 21 is cancelled by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-6, 10, 12, 14-17, 19, 20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwabe et al. (US Patent No. 6,880,155 – ('155)) and in view Schwabe et al. (US Patent No. 6,981,245 – ('245)).

As per claim 1, Schwabe ('155) teaches: a conversion step for converting said reduced file into a corresponding converted reduced code file that is semantically identical to said reduce file, wherein the reduce file is created from an original code file that contains classes that are capable of being compiled and wherein the only executable instructions in the reduced file are applets [Fig. 4, col. 6 lines 51-67, col. 10 lines 61-67, col. 11 lines 1-5], wherein said conversion step further includes: a preconversion subset for converting card Ids contained in said reduced file into symbolic names, and for converting said reduced file into a standard language format used by a condensed interpreted

language, to obtained a preconverted file [col. 7 lines 27-52]; and mapping subset for replacing in said preconverted file, externally defined names with original names by using a mapping scheme between names used by the reduced file and tokenized identifiers, to obtain the converted reduced code file [col. 7 lines 27-52, col. 8 lines 17-39, col. 10 lines 14-21].

Further, in an analogous art, Schwabe ('245) teaches a method for language verification of a reduced file to be stored in and used by a chipcard, wherein the reduced file is created from an original code file [Fig. 4, 10A, 11B, 11C, col. 1 lines 44-51, col. 6 lines 60-67], a language-verification step for verifying said converted reduced code file for compliance with pre-specified language specifications of the condensed interpreted language [col. 10 lines 48-60, Fig. 10A-10D, col. 14 lines 37- col. 18 lines 25]. Further, Schwabe ('245) teaches wherein the reduce file is created from an original code file that contains classes that are capable of being compiled and wherein the only executable instructions in the reduced file are applets [Fig. 5, col. 7 lines 11-27].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Schwabe ('245) with Schwabe ('155), since one would have been motivated to provide verification that ensures binary compatibility that avoid run time error [Schwabe ('245), col. 11 lines 49-53].

As per claim 3, the rejection of claim 1 is incorporated and Schwabe ('155) teaches: wherein said mapping subset is performed using a referenced export file which is available as a result of creating said reduced file from said original code file [Fig. 4A-4B, 5, col. 7 lines 7-53].

As per claim 4, the rejection of claim 1 is incorporated and Schwabe ('245) teaches: a signature step for creating, after verification of said converted reduced code file in said language verification step, a cryptographic signature file for the reduce file [Fig. 12, 14].

As per claim 5, the rejection of claim 4 is incorporated and Schwabe ('245) teaches:

A loading step for loading the cryptographic signature file to a chipcard together with the reduced file, wherein the cryptographic signature file is attached to the reduced file when loaded in the chipcard [Fig. 12, 14].

As per claim 6, the rejection of claim 4 is incorporated and Schwabe ('245) teaches:

An executing step for executing said reduced file upon a positive cryptographic verification [col. 4 lines 20-44, Fig. 12, 14].

As per claim 10, it encompasses limitations that are similar to limitations of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 12, it encompasses limitations that are similar to limitations of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 14, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 3. Thus, it is rejected with the same rationale applied against claim 3 above.

As per claim 15, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 4. Thus, it is rejected with the same rationale applied against claim 4 above.

As per claim 16, the rejection of claim 15 is incorporated and it encompasses limitations that are similar to limitations of claim 6. Thus, it is rejected with the same rationale applied against claim 6 above.

As per claim 17, it encompasses limitations that are similar to limitations of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 20, it encompasses limitations that are similar to limitations of claims 1, 4, 5. Thus, it is rejected with the same rationale applied against claim 1, 4, 5 above.

As per claim 22, the rejection of claim 20 is incorporated and Schwabe ('155) teaches: the reduce file is created from an original code file that contains classes that are capable of being compiled and wherein the only executable instructions in the reduced file are applets [Fig. 4, col. 6 lines 51-67, col. 10 lines 61-67, col. 11 lines 1-5]. Further, Schwabe ('245) teaches wherein the reduce file is created from an original code file that contains classes that are capable of being compiled and wherein the only executable instructions in the reduced file are applets [Fig. 5, col. 7 lines 11-27].

Note: Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Response to Amendment

3. Applicant has amended claims 1, 3-6, 10, 12, 14-17, 19, 20, 22 which necessitated new ground of rejection. Applicant's argument presented in previous response is moot in view of new ground of rejection. See new ground of rejection above.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIRAV PATEL whose telephone number is (571)272-5936. The examiner can normally be reached on 8 am - 4:30 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NBP

5/23/08

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135